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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,650	10/22/2003	Haruo Akiba	244334US3	5962
22850	7590	01/04/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			KASZTEJNA, MATTHEW JOHN	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/689,650

Applicant(s)

AKIBA, HARUO

Examiner

Matthew J. Kasztejna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Notice of Amendment***

In response to the amendment filed on November 14, 2005, amended claims 1 and 11 are acknowledged. The current rejections of claims 1-11 *stand*. The following reiterated grounds of rejection are set forth:

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,863,286 to Yabe et al.

**In regards to claims 1 and 10-11**, Yabe et al. disclose a valved plug 61 to be fitted on a mouth piece at an inlet opening of an instrument entrance passage leading to a biopsy channel of an endoscopic insertion tube, the plug being formed of a resilient material in its entirety and having, at opposite ends of a foldable connecting strip 65, a generally tubular main body portion internally formed with a constricted passage of a smaller diameter as compared with the inlet opening of the instrument entrance passage at an intermediate portion between outer and inner ends thereof, and a nesting piece adapted to be detachably and tightly coupled with the main body portion and having a normally closed slit valve in axial alignment with the constricted passage in the main body portion to permit insertion of an instrument therethrough, wherein: the

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main body 63 portion is provided with an interlocking inward projection of a predetermined thickness at an outer end to be coupled with the nesting piece 64; the nesting piece is provided with an annular interlocking groove around an outer periphery thereof, the interlocking groove being narrower the predetermined thickness of the interlocking projection and adapted to grip the interlocking projection tightly in a compressed state from upper lower and inner sides; and the slit valve being located in an axially spaced position from the constricted passage and opened toward the constricted passage upon insertion of an instrument (see Figs. 5 and 11 and Col. 10, Line 57 - Col. 11, Line 21).

**In regards to claim 2**, Yabe et al. disclose a valved plug wherein the interlocking projection is an annular ledge projecting radially inward from an outer end of the main body portion on the outer side of the constricted passage (see Fig. 11)

**In regards to claim 3**, Yabe et al. disclose a valved plug wherein the annular ledge is so dimensioned as to have an inside diameter smaller than diameter of the annular interlocking groove of the nesting piece (see Fig. 11).

**In regards to claim 4**, Yabe et al. disclose a valved plug wherein an annular recess is formed between the interlocking projection and the constricted passage of the main body portion, the annular recess being so dimensioned as to have an inside diameter smaller than outside diameter of the interlocking groove on the side of the nesting piece (see Fig. 11).

**In regards to claim 5**, Yabe et al. disclose a valved plug wherein the interlocking projection of the main body portion is tightly engaged with the interlocking groove on

the side of the nesting piece through tapered or inclined surfaces and retained in an interlocked state more tightly by wedge-like actions of the tapered surfaces when an axial force is exerted thereto from inside of the biopsy channel (see Fig. 11 and Col. 11, Lines 1-21).

**In regards to claim 6**, Yabe et al. disclose a valved plug wherein the circular body portion of the nesting piece is formed in a hemispherical cup-like shape, and the slit is formed across a bottom portion of the hemispherical body portion (see Fig. 11).

**In regards to claim 7**, Yabe et al. disclose a valved plug wherein the main body is internally provided with a hollow cavity 63a under the constricted passage, and the slit is formed radially within a range of the hollow cavity (see Fig. 11).

**In regards to claim 8**, Yabe et al. disclose a valved plug wherein the slit is formed in an area inward of the interlocking projection on the side of the main body portion of the plug (see Fig. 11).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,863,286 to Yabe et al. in view of U.S. Patent No. 4,715,360 to Akui et al.

**In regards to claim 9**, Yabe et al. disclose a valved plug 61 to be fitted on a mouth piece at an inlet opening of an instrument entrance passage leading to a biopsy

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channel of an endoscopic insertion tube but is silent with respect to wherein a ridge is formed on one of engaging surfaces of the main body portion and nesting piece, the ridge being adapted to be deformed into a flattened shape by compression as the nesting piece is coupled with the main body portion of the plug. Akui et al. teach of an analogous valved plug having a ridge being adapted to be deformed into a flattened shape by compression as the nesting piece is coupled with the main body portion (see Col. 5, Lines 37-54). It would have been obvious to one skilled in the art at the time the invention was made to include a deformable ridge in the apparatus of Yabe et al. to ensure a secure fit between the nesting portion on the main body of the valved plug, as taught by Akui et al.

### ***Response to Arguments***

Applicant's arguments filed November 14, 2005 have been fully considered but they are not persuasive.

Applicant states that Yabe et al. contains no teaching that the flange 64a is fitted in the recess 63d in a compressed state and that it *appears* that there is a gap space on the upper or outer side of the flange 64a which is fitted in the recess 63d of a larger width. However, it is unclear where a gap appears in Figures 5 and 11. Furthermore, the flange 64a is inherently held in a compressed state otherwise the plug body 64 would not be held securely within plug member 63, and thus fail to perform its desired function. There are forces exerted on the interlocking projection from upper, lower and inner sides to ensure a compressed state and a secure fitting, as seen from Figure 5.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the slit valve can be pushed open smoothly toward the constricted passage within a space which is provided between the slit valve and the constricted passage) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As broadly as claimed, Yabe et al. disclose a valved plug wherein the slit valve is located in an axially spaced position from the constricted passage and opened toward the constricted passage upon insertion of an instrument (see Col. 11, Lines 1-21).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

  
BEVERLY M. FLANAGAN  
PRIMARY EXAMINER

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJK 

12/30/05